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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/088,174 | 06/19/2002 | Ducroix Bertrand | P07566USOO/BAS | 8862 |

881 7590 11/04/2004

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| EXAMINER | |
|---|---|
| EGWIM, KELECHI CHIDI | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1713 | |

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|---|---|---|
| | 10/088,174 | BERTRAND ET AL. |
| | Examiner | Art Unit |
| | Dr. Kelechi C. Egwim | 1713 |

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *21 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *11,14,15,17 and 18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11,14,15,17 and 18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 11, 14, 15 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Breant, Skipper, Bartholomeus et al. or Anzini et al.

In col. 2, lines 23-61 and col. 5, lines 14-21, Breant teaches an extrudable material including a thermoplastic polymer phase containing at least one of the present olefinic polymers, 120 to 240 parts (about 55 to 71 weight % of the composition) of a content filler such as calcium carbonate, said material having a tensile strength of at least 10 MPa and an amount of extension at breakage of at least 110%.

In Tables 1 and 2, Skipper teaches an extrudable material including: a thermoplastic polymer phase containing at least one of the present olefinic polymers, 100 parts (50% of the composition) of a content filler, said material having a tensile strength around 11 or 12 MPa and an amount of extension at breakage from 102 to 230%.

In page 2, line 15 to page 3, line 6 and the Examples, Bartholomeus et al. teach an extrudable material including a thermoplastic polymer phase containing at least one of the present olefinic polymers, 150 to 260 parts of a content filler, based on 100 parts

of polymer, said material having tensile strengths from approximately 5 to 9 $N/mm^2$ (MPa) and an amount of extension at breakage from 140 to 200%.

In Examples 5 and 11, Anzini et al. teach an extrudable material including a thermoplastic polymer phase containing at least one of the present olefinic polymers, 200 parts of a content filler, based on 150 parts of polymer (about 57% of the composition), said material having tensile strengths from 950 to 1029 psi (6.55 to 7 MPa) and an amount of extension at breakage from 150 to 196%.

While Breant, Skipper, Bartholomeus et al. or Anzini et al., do not report data with regard to "Shore D Hardness" as claimed, it is reasonable that the thermoplastic materials of Breant, Skipper, Bartholomeus et al. or Anzini et al. would possess the presently claimed property since the prior art thermoplastic materials are essentially the same as the claimed composition and the USPTO does not have at its disposal the tools or facilities deemed necessary to make physical determinations of the sort. In any event, an otherwise old composition is not patentable regardless of any new or unexpected properties. In re Fitzgerald et al , 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 11, 14, 15, 17 and 18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Himes et al., for reasons cited in the previous action.

### *Response to Arguments*

5. Due to amendments by applicant, the previous 112 rejections of record have been overcome and are hereby withdrawn.

6. Applicant's arguments filed 09/21/2004 have been fully considered but they are not persuasive.

7. Regarding applicant's arguments that "the material is not defined only by the nature of its constituents but also by the fact that it complies with three mechanical properties", the examiner disagrees, since it is the nature of the constituents that inherently result in the mechanical properties.

8. Regarding Himes, a slightly different intended use does not constitute "teaching away". Also, the fact that the prior art chooses a different method for testing for the same property is not necessarily a pre-determinant of the results of either test.

9. It is still it is reasonable that the thermoplastic materials of the prior art would possess the presently claimed property, as the prior art thermoplastic materials are still essentially the same as the claimed composition. The USPTO does not have at its disposal the tools or facilities deemed necessary to make physical determinations of the sort and, in any event, an otherwise old composition is not patentable regardless of any new or unexpected properties. In re Fitzgerald et al , 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art.

10. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., 0.1 mm thick extrude films, satisfactory cylindrical shape, etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KCE

KELECHI C. EGWIM PH.D.
PRIMARY EXAMINER